

C.) REMARKS

This Response is filed in response to the Office Action dated September 10, 2007.

Upon entry of this Response, claims 1-5, 7 and 9-26 will be pending in the Application.

In the outstanding Office Action, the Examiner rejected claims 4 and 7 under 35 U.S.C. 112, second paragraph, as being indefinite; rejected claims 1, 6-9, 12-13, 16-18, 20-21 and 24-26 under 35 U.S.C. 102(b) as being anticipated by Stead et al. (U.S. Patent Application Publication No. 2002/0002627); rejected claims 2-5, 14-15, 19 and 22-23 under 35 U.S.C. § 103(a) as being unpatentable over Stead et al. (U.S. Patent Application Publication No. 2002/0002627) in view of Official Notice; and indicated claims 10 and 11 would be allowable if rewritten in independent form.

Rejection under 35 U.S.C. 102

The Examiner rejected claims 1, 6-9, 12-13, 16-18, 20-21 and 24-26 under 35 U.S.C. 102(b) as being anticipated by Stead et al. (U.S. Patent Application Publication No. 2002/0002627), hereinafter referred to as "Stead."

Specifically, the Examiner stated that

As per claim 1, Stead et al. teaches a method of remotely monitoring building equipment comprising the steps of: providing at least one item of building equipment (e.g. Figure 2 elements 90) communicably linked to a router (e.g. Figure 2 elements 80), the router being communicably linked to an instant messaging server (e.g. interpreted to correspond to Figure 2 element 30; Also see {0009}, {0018} and {0061}); providing at least one remotely located interface (e.g. Figure 2 element 10), the at least one remotely located interface being communicably linked to the instant messaging server; gathering data from the at least one item of building equipment with the router; and transmitting the data from the router to the at least one remotely located interface in an instant message through the instant messaging server (e.g. {0012}).

Applicant respectfully traverses the rejection of claims 1, 6-9, 12-13, 16-18, 20-21 and 24-26 under 35 U.S.C. 102(b). Claims 6 and 8 have been cancelled herein, thereby rendering the rejection thereagainst moot. The features of claims 6 and 8 have been incorporated into claim 1 and will be discussed with regard to claim 1.

Stead, as understood, is directed to a method and system for interconnecting remote intelligent devices, without using special remote applications, with a network that includes Proxy

applications, for remote control purposes. In one embodiment a system is provided for interconnecting an intelligent device with a remote element. The system has a manager module and a tail module. The manager module is adapted for communication with the intelligent device. The tail module is interfaced with the manager module according to an application program interface, and interfaced to the remote element. The manager module and the tail module provide interconnection of the intelligent device to the remote element when the intelligent device is in communication with the manager module. The system can also be a Wireless or Wired Interconnection Proxy Involving Tails ("WIPIT").

In contrast, independent claim 1, as amended, recites a method of remotely monitoring building equipment comprising: providing at least one item of building equipment communicably linked to a router, the router being communicably linked to an instant messaging server; providing at least one remotely located interface, the at least one remotely located interface being communicably linked to the instant messaging server; gathering data from the at least one item of building equipment with the router; packetizing the gathered building equipment data into at least one data packet; encapsulating the at least one data packet into the instant message; and transmitting the encapsulated at least one data packet in an instant message from the router to the at least one remotely located interface through the instant messaging server.

Independent claim 18 recites a system for remotely monitoring building equipment, the system comprising: at least one item of building equipment; a router communicably connected to the at least one item of building equipment to receive data from the building equipment, the router having a microprocessor and a memory storing computer program executable by the microprocessor, the computer program comprising computer instructions for gathering data from the connected building equipment, converting the data, packetizing the converted data, and encapsulating the packetized data into an instant message; and an instant messaging server communicably connected to the router, the instant messaging server being configured to receive an instant message from the router and to transmit the instant message to at least one remotely located interface.

The examiner is reminded that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.’ *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).” See Manual of Patent Examining Procedure, 8th Edition, Revision 6 (MPEP), Section 2131.

In addition, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.’ *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).” See MPEP, Section 2131.

Several of the features recited by Applicant in independent claims 1 and 18 are not taught or suggested by Stead. First, Stead does not teach or suggest packetizing the gathered building equipment data into at least one data packet; encapsulating the at least one data packet into the instant message; and transmitting the encapsulated at least one data packet in an instant message as recited by Applicant in independent claims 1, nor converting the data, packetizing the converted data, and encapsulating the packetized data into an instant message as recited by Applicant in independent claim 18. Stead does not teach or suggest the transmission of data via instant messages nor the packetizing of data and the encapsulating of data packets as recited in independent claims 1 and 18. The Examiner attempts to remedy this lack of teaching in Stead by asserting that the above-identified features are inherent to Stead and the use of Internet Protocols for remotely monitoring building equipment via instant messages. However, the Examiner's attempt to use inherency in this context is clearly misplaced because the Examiner has provided no objective evidence or cogent technical reasoning as to why the recited features would be inherent in Stead. Applicant submits that the mere fact that Stead may disclose an instant messaging server is not in and of itself enough to show that Stead would teach or suggest the transmission of building equipment data in an instant message, let alone teach or suggest the packetization of data or the encapsulation of data packets into instant messages. The Examiner has failed to provide any evidence or reasoning as to why Applicant's recited features would be inherent in the WAP server recited in Stead.

The Examiner is referred to MPEP Section 2112, an excerpt of which is provided below, that is directed to the use of inherency in formulating rejections.

IV. EXAMINER MUST PROVIDE RATION- ALE OR EVIDENCE TENDING TO SHOW INHERENCY

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijkensart*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Gehrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted) (The claims were drawn to a disposable diaper having three fastening elements. The reference disclosed two fastening elements that could perform the same function as the three fastening elements in the claims. The court construed the claims to require three separate elements and held that the reference did not disclose a separate third fastening element, either expressly or inherently). "Also, '[a]n invitation to investigate is not an inherent disclosure' where a prior art reference 'discloses no more than a broad genus of potential applications of its discoveries.'" *Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings*, 370 F.3d 1354, 1367, 71 USPQ2d 1081, 1091 (Fed. Cir. 2004) (explaining that "[a] prior art reference that discloses a genus still does not inherently disclose all species within that broad category" but must be examined to see if a disclosure of the claimed species has been made or whether the prior art reference merely invites further experimentation to find the species.).

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original) (Applicant's invention was directed to a biaxially oriented, flexible dilation catheter balloon (a tube which expands upon inflation) used, for example, in clearing the blood vessels of heart patients). The examiner applied a U.S. patent

to Schjeldahl which disclosed injection molding a tubular preform and then injecting air into the preform to expand it against a mold (blow molding). The reference did not directly state that the end product balloon was biaxially oriented. It did disclose that the balloon was "formed from a thin flexible inelastic, high tensile strength, biaxially oriented synthetic plastic material." *Id.* at 1462 (emphasis in original). The examiner argued that Schjeldahl's balloon was inherently biaxially oriented. The Board reversed on the basis that the examiner did not provide objective evidence or cogent technical reasoning to support the conclusion of inherency).

In the Office Action, the Examiner has provided no basis in fact or technical reasoning to support the Examiner's determination that the allegedly inherent characteristics necessarily flow from the disclosure in Stead. Thus, Applicant submits that the Examiner has improperly used an inherency argument in his rejection and has failed to identify in Stead all of the features recited by Applicant in independent claims 1 and 18.

Thus, since Stead does not teach or suggest all of the limitations recited in independent claims 1 and 18, Applicant respectfully submits that Stead does not anticipate Applicant's invention as recited in independent claims 1 and 18.

Therefore, for the reasons given above, independent claims 1 and 18 are believed to be distinguishable from Stead and therefore are not anticipated nor rendered obvious by Stead.

Dependent claims 7, 9, 12-13, 16, 17, 20-21 and 24-26 are believed to be allowable as depending from what are believed to be allowable independent claims 1 and 18 for the reasons given above. In addition, claims 7, 9, 12-13, 16, 17, 20-21 and 24-26 recite further limitations that distinguish over the applied art. In conclusion, it is respectfully submitted that claims 1, 7, 9, 12-13, 16-18, 20-21 are not anticipated nor rendered obvious by Stead and are therefore allowable.

Rejection under 35 U.S.C. 103

The Examiner rejected claims 2-5, 14-15, 19 and 22-23 under 35 U.S.C. § 103(a) as being unpatentable over Stead in view of Official Notice.

Applicant respectfully traverses the rejection of claims 2-5, 14-15, 19 and 22-23 under 35 U.S.C. § 103(a).

Stead is directed to a system for interconnecting remote devices as discussed in greater detail above.

Applicant submits that dependent claims 2-5, 14-15, 19 and 22-23 are distinguishable from Stead and/or Official Notice for at least the following reasons. Dependent claims 2-5, 14-15, 19 and 22-23 are believed to be distinguishable from Stead and/or Official Notice as depending from what are believed to be allowable independent claims 1 and 18 as discussed above.

Therefore, in view of the above, dependent claims 2-5, 14-15, 19 and 22-23 are believed to be distinguishable from Stead and/or Official Notice and therefore are not anticipated nor rendered obvious by Stead and/or Official Notice. In addition, claims 2-5, 14-15, 19 and 22-23 recite further limitations that distinguish over the applied art. For example, dependent claim 19 recites "at least one item of building equipment has an assigned unique electronic address to permit electronic identification of the equipment, and wherein the assigned unique electronic address further comprises a portion of an electronic profile for the equipment," which feature is not taught or suggested by Stead or within the scope of the Examiner's taken Official Notice. In conclusion, it is respectfully submitted that claims 2-5, 14-15, 19 and 22-23 are not anticipated nor rendered obvious by Stead and/or Official Notice and are therefore allowable.

Rejection under 35 U.S.C. 112

The Examiner rejected claims 4 and 7 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter applicant regards as the invention.

Applicant respectfully traverses the rejection of claims 4 and 7 under 35 U.S.C. 112, second paragraph.

The Examiner stated that in claim 4, the language "for the instant message identifier of the at least one remotely located interface" lacked proper antecedent basis and stated that in claim 7, the language "wherein the step of packetizing the data" lacked proper antecedent basis. In response thereto, Applicant has amended claims 4 and 7 in a manner that is believed to overcome the Examiner's rejection.

Therefore, in view of the above, Applicant submits that claims 4 and 7 are not indefinite and comply with the provisions of 35 U.S.C. 112, second paragraph, and therefore are allowable.

Allowable Subject Matter

The Examiner objected to claims 10 and 11 as being dependent upon a rejected base claim, but indicated that the claims would be allowable, if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In response thereto, claim 10 has been amended to incorporate the limitations of claim 1. Thus, claims 10 and 11 are now believed to be allowable.

CONCLUSION

In view of the above, Applicant respectfully requests reconsideration of the Application and withdrawal of the outstanding objections and rejections. As a result of the amendments and remarks presented herein, Applicant respectfully submits that claims 1-5, 7, 9-26 are not anticipated by nor rendered obvious by Stead, Official Notice or their combination and thus, are in condition for allowance. As the claims are not anticipated by nor rendered obvious in view of the applied art, Applicant requests allowance of claims 1-5, 7, 9-26 in a timely manner. If the Examiner believes that prosecution of this Application could be expedited by a telephone conference, the Examiner is encouraged to contact the Applicant.

The Commissioner is hereby authorized to charge any additional fees and credit any overpayments to Deposit Account No. 50-1059.

Respectfully submitted,
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